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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,906	03/09/2004	Masami Suzuki	12587-048001 / D03-047/01	3382
26212 7590 03/26/2009 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			NOTIFICATION DATE 03/26/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/797,906	Applicant(s) SUZUKI ET AL.	
	Examiner JASON B. DUNHAM	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 38-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 38-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 19, 2008 has been entered. Applicant amended claim 1, canceled claims 2-37, and added new claims 38-58. Claims 1 and 38-58 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 38-51 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

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process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1 and 38-51 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-

[http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)

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Referring to claim 52. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and

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computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claim 52 fails to recite a computer program that is embodied on a statutory computer-readable medium; applicant’s specification paragraph 88 discloses mediums as non-statutory signals. See MPEP 2106.01 directed towards computer related non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 38-43, and 45-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Jin (US 2005/0033648).

Referring to claim 1. Jin discloses a computer implemented method comprising:

receiving, at a third party facilitator of a transaction, a file including item description data which describes items, and enhanced data which specifies an approach for conducting the transaction and which supplies value benchmarks for the items (abstract disclosing an online auction listing service, figure 1 disclosing receiving client files containing product information, and figure 3 disclosing selling items at price percentages of cost);

monitoring performance of the transaction as the transaction is being facilitated by the third party facilitator over one or more online channels (figure 10 and paragraph 102);

calculating metrics for the items based on comparing the monitored performance of the transaction to the supplied value benchmarks (paragraph 102 and table 3 disclosing cost recovery for transactions);

presenting a dashboard interface to an owner of items, the dashboard interface providing the calculated metrics and a recommendation of the third party facilitator for improving the performance of the transaction (paragraph 10 disclosing an interface with business rule definition logic for optimizing returns by adjusting price and quantity of items sold);

permitting the owner to adjust the approach for conducting the transaction, using the dashboard interface (figures 14-15 and paragraphs 111-113); and

facilitating the transaction according to the adjusted approach (figure 16).

Referring to claim 38. Jin further discloses a method wherein permitting the owner to adjust the approach further comprises permitting the owner to adjust a quantity and type of the items being transacted (paragraph 111).

Referring to claim 39. Jin further discloses a method wherein facilitating the transaction further comprises selecting a fulfillment center that is appropriate to the items, based on the description data or the enhanced data (paragraph 62 disclosing moving inventory among various sale channels).

Referring to claim 40. Jin further discloses a method wherein:
receiving the file further comprises, at the third party facilitator:
receiving an indication from the owner that the items represent fragmented inventory, inventorying the items, assigning unique identifies to the inventoried items, generating the description data, generating the file, and populating the file with the unique identifies and the description data (figure 15 disclosing inventorying surplus items (such as computers) by SKU number along with description data).

Referring to claims 41-43. Jin further discloses a method wherein the enhanced data which specifies the approach for conducting the transaction specifies which of the one or more online channels to use in conducting the transaction, how the items should be displayed and sold, and which of the items should be grouped together (figure 13 disclosing selection of an online channel, selection of a product image, and selection of a category to group the item into).

Referring to claim 45. Jin further discloses a method wherein the value benchmarks comprise an anchor price for each of the items, and an anchor price flag representing a cost of goods sold (figure 3).

Referring to claim 46. Jin further discloses a method wherein the value benchmarks comprise an average sales price per SKU associated with each item (figure 5 disclosing cost recovery rates for items by SKU number).

Referring to claims 47-48. Jin discloses providing an interface identifying sales reports for listed items (figure 10). The examiner notes that the contents of the dashboard are non-functional descriptive material. Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate- In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II. There is no functional relationship between the display of output information (i.e. top-line and bottom-line highlights) and processing the received information.

Referring to claim 49. Jin further discloses a method wherein the transaction comprises a sales transaction (abstract).

Referring to claims 50-51. Jin further discloses a method comprising determining the recommendation at third party facilitator and wherein the recommendation is not provided by the owner (paragraph 10 disclosing default optimization logic based on previous sale data).

Referring to claims 52-58. Medium and system claims 52-58 are rejected under the same rationale provided above in the rejection of method claims 1 and 38-42 containing similar limitations).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jin (US 2005/0033648) in view of Official Notice.

Referring to claim 44. Jin discloses all of the above as noted in the 35 USC 102(e) rejection but does not expressly disclose specifying whether customer feedback for the owner should be displayed on the one or more online channels. The examiner takes Official Notice that it was old and well known in the art at the time of applicant's

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invention to have allowed an owner to specify whether customer feedback should be displayed on online channels such as auction sites.

Response to Arguments

Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection. Furthermore, applicant's arguments filed November 24, 2008 regarding Jin have been fully considered but they are not persuasive. Applicant argues that Jin does not disclose the recommendation feature, as recited in claim 1. The examiner respectfully disagrees. Jin does provide for user creation of business logic rules to facilitate sales, however Jin also provides for default logic that is implemented on the basis of previous sale results (paragraph 10)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Dunham/ 3/20/09